

REMARKS

Upon entry of the instant amendment, claims 1-7, 10-17, and 20 are pending in this application. While claims 15-17 have been objected to as containing allowable subject matter, claims 1-14 and 18-20 stand rejected on prior art grounds, particularly as anticipated by and/or obvious in view of Babb et al. Herein, Applicants have amended claim 1 to be distinct from the Babb reference. Specifically, claim 1 as amended now specifies that the first and second conductive members are parallel and substantially straight along their respective longitudinal axes and that the resistive heating element extends in a linear fashion from the distal end of one to the distal end of the other so as to form an acute angle with the longitudinal axis of said first conductive member, the angle dictated by the respective lengths of the conductive members and the spacing there between. Support for this amendment is found in the specification as originally filed, particularly p. 6, lines 27-30, original claim 9, and Figure 3. Applicants respectfully submit that the presently claimed configuration is neither disclosed nor suggested by the Babb reference. Applicants further submit that no new matter has been added.

In sum, Applicants submit that the instant response renders moot the outstanding objections and rejections set forth in the Final Office Action of April 29, 2005 and places the instant application in condition for allowance. Accordingly, Applicants respectfully request that the Examiner reconsider his position in the in light of the amendments and remarks herein:

Drawings:

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) as failing to depict the flat scoop recited in claim 5. Accordingly, Applicants submit herewith new Figures 12 and 13 depicting the flat scoop embodiment. Applicants respectfully submit that no new matter has been added.

Rejections under Section 102:

Claims 1-7, 9-12, 14, and 18-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Babb, U.S. Patent No.3,234,356. According to the Examiner, Babb teaches a suture removal instrument that anticipates Applicants' claims. Applicants respectfully disagree.

At the outset, Applicants note that this rejection is now moot with respect to claims 9, 18, and 19, presently canceled. With regard to the remaining claims, Applicants respectfully submit

that the present amendment distinguishes the invention of the pending claims from that of Babb. Recall, in order to anticipate a claim, a single reference must disclose *each and every element* of the claim. However, in contrast to Babb, amended claim 1 defines the first and second conductive members as extending in a parallel fashion and being substantially straight along their respective longitudinal axes. Likewise, in contrast to Babb, Applicants' resistive heating element is defined as extending in a linear fashion between the distal ends of said first and second conductive members, so as to form an acute angle with the longitudinal axis of said first conductive member, said angle dictated by the respective lengths of the conductive members and the spacing there between. Applicants respectfully submit that this claimed arrangement is neither disclosed nor suggested by Babb.

Specifically, Babb's second music wire electrode is "bent at approximately a forty-five degree angle toward the first electrode . . . then cut so that the tip of [the second music wire electrode] is disposed in front of that of the [first music wire electrode]" [col. 2: 38-43 & col. 6: 1-10]. As such, the distal ends of Babb's electrodes are essentially co-linear. Conversely, Applicants' first and second conductive members extend in a parallel fashion and are substantially straight along their respective longitudinal axes. Similarly, in contrast to the Babb arrangement, Applicants' resistive heating element extends in a linear fashion between the distal ends of said first and second conductive members, so as to form an acute angle with the longitudinal axis of said first conductive member, said angle dictated by the respective lengths of the conductive members and the spacing there between. Conversely, Babb's heater element is essentially an extension of the first music wire electrode, being co-linear therewith and essentially parallel to the longitudinal axis of the second music wire electrode. Moreover, any angle formed between the heater element and the second music wire electrode is merely incidental to microwelding ("the forward end of the wire heater element may, when desired, be pointed down at the weld to preclude any snagging action as the electrode is inserted beneath the suture to be cut"; col. 6: 13-18) and is not, in fact, dictated by the respective lengths of the conductive members and the spacing there between. Moreover, the formation of an angle between the heater element and the second music wire electrode necessarily disrupts the linear nature of the heater element. Accordingly, Applicants respectfully submit that the arrangement now claimed is neither disclosed nor suggested by Babb.

In sum, as the Babb reference fails to disclose one or more claim elements of the pending claims, it cannot anticipate the invention as presently claimed. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-7, 9-12, 14, and 18-20 under 35 U.S.C. § 102(b) as being anticipated by Babb.

Rejections under Section 103:

Claims 5 and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Babb. According to the Examiner, while Babb fails to teach a tapered tip with a flat scoop as recited in claim 5, "it would have been obvious to one having ordinary skill in the art to make the tapered tip of Babb more flat/shovel like to avoid piercing the patient's skin." With respect to claim 13, the Examiner suggests that it would have been obvious to modify the Warthen device to include a power cord adapted for connection to a wall outlet as recited in claim 13 so as to "it is well known in the art of hand-held device [sic] to include a power cord for connection to a wall outlet."

Applicants respectfully submit that, for the reasons set forth above, the invention of the pending claims is neither disclosed nor suggested nor rendered obvious by the Babb reference. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 5 and 13 under 35 U.S.C. § 103(a) as being obvious in view of Babb.

Allowable Subject Matter:

Claims 15-17 were objected to as being dependent upon a rejected base claim but would be indicated allowable if rewritten in independent form. Applicants thank the Examiner for the indication of allowable subject matter. However, Applicant respectfully submits that when the Examiner reconsiders the pending claims in view of the remarks herein, he will find that the remaining claims, claims 1-7, 10-14, and 20, also contain allowable subject matter.

CONCLUSION

In sum, Applicant submits that the claims herein set forth a novel, non-obvious invention. Accordingly, Applicant submits that claims 1-7, 10-17, and 20 as amended herein are in condition for allowance and respectfully petition for an early notice of allowance.

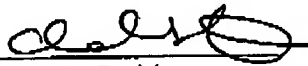
The previous Office Action, mailed April 29, 2005, set forth a three-month period for response. Accordingly, as Applicants submit herewith a petition for one-month extension of time and the requisite fee, response is due on or before August 29, 2005. Thus, Applicant submits that this response is timely and no additional fees are required. However, in the event that additional fees are required to maintain the pendency of this application, the Commissioner is authorized to charge such fees to Deposit Account No. 50-2101.

Respectfully submitted,

Date: August 2, 2005

Smith Patent Consulting, LLC
P.O. Box 2726
Alexandria, VA 22301
Telephone: (703) 549-7691
Facsimile: (703) 549-7692

By


Chalin A. Smith
Attorney for Applicant
Registration No. 41,569

CUSTOMER NUMBER 31,496

Amendments to the Drawings:

The attached new sheets of drawings include new Figures 12 and 13.

Attachment: New drawings sheets depicting new Figures 12 and 13.